

## **REMARKS/ARGUMENTS**

Claims 1-30 are pending in the present application.

This response is to respond the Office Action mailed November 10, 2009. In the Office Action, the Examiner rejected claims 1-7, 10-17, 20-27, and 30 under 35 U.S.C. §102(e) claims 8-9, 18-19, and 28-29 under 35 U.S.C. §103(a). Applicant has amended claim 1 to correct minor informalities. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

### ***Rejection Under 35 U.S.C. § 102***

In the Office Action, the Examiner rejected claims 1-7, 10-17, 20-27, and 30 under 35 U.S.C. §102(e) as being anticipated by U.S. Publication No. 2009/0164595 A1 issued to Shiigi ("Shiigi"). Applicant respectfully traverses the rejection and submits that the Examiner has not met the burden of establishing a *prima facie* case of anticipation.

Shiigi discloses a method and system for creating and sending handwritten or handdrawn messages via mobile devices. The handwritten message is composed by the user in a graphical data capture area set up by the drawing editor, selecting the appropriate writing and drawing tools, colors, and styles as offered in the Handwriting Java Client software (Shiigi, paragraph [0031], lines 13-14, item 3). When the user issues a "Send" command, the Handwriting Java Client formats the message and sends the pixel data to the Handwriting Java Server. The graphical message is still in GIF format at this time (Shiigi, paragraph [0031], lines 23-26, item 5). The Handwriting Java Server processes the graphical message data using standard base64 encoding. This turns the data into ASCII text that can be transmitted as standard email data packets by the Handwriting Java Server (Shiigi, paragraph [0031], lines 27-30, item 6). The Handwriting Java Server creates an outgoing email message that contains the encoded handwritten message as a GIF attachment (Shiigi, paragraph [0031], lines 31-33, item 7). The Handwriting Java Server decodes the attached GIF file into pixel data and sends it to the Handwriting Java Client applet running in the recipient's web browser (Shiigi, paragraph [0031], lines 55-57, item 11b).

Shiigi does not disclose, either expressly or inherently, at least one of: (1) an encoder to encode data in a first format from an input device into a string of data having a second format

supported by a server having an infrastructure, the first and second formats being different; and (2) a packetizer coupled to the encoder to break the string of data into packets no larger than maximum message size allowed by the infrastructure, the packets having at least one packet having a header, the header identifying the first format; and (3) a decoder to decode a received packet encoded in the second format back into the data having the first format.

First, Shiigi merely discloses selecting the appropriate writing and drawing tools, colors, and styles as offered in the Handwriting Java Client software (Shiigi, paragraph [0031], lines 13-14, item 3), NOT encoding data in a first format from an input device into a string of data having a second format. The writing and drawing tools merely provide support for the user to write and to draw. These tools do not encode the data from a first format into a string of data in a second format.

Second, Shiigi merely discloses creating an outgoing email message that contains the encoded handwritten message as a GIF attachment (Shiigi, paragraph [0031], lines 31-33, item 7), NOT a packetizer coupled to the encoder to break the string of data into packets no larger than maximum message size allowed by the infrastructure, the packets having at least one packet having a header, the header identifying the first format. Attaching a GIF file to an email message does not break the string of data into packets. The GIF file remains intact because it is an attachment and not a part integral to the email message.

Third, Shiigi merely discloses decoding the attached GIF file into pixel data (Shiigi, paragraph [0031], lines 55-57, item 11b), NOT a decoder to decode a received packet encoded in the second format back into the data having the first format. Decoding the GIF file into pixel data merely decompiles a file into pixel components. It does not convert the second format into the first format.

Applicant notes that the Examiner merely refers to the paragraphs without identifying the relevant elements in the cited excerpts that correspond to the claim elements. Accordingly, **Applicant requests the Examiner to explicitly identify, preferably with line numbers, the particular elements in the cited paragraphs that correspond to the first format and the second format.**

Applicant also notes that the rejected claim does not recite “a management layer”.

Accordingly, the Examiner’s remark on the management layer on page 3 of the Office Action is irrelevant. Applicant respectfully requests the Examiner to remove this portion of the discussion.

To anticipate a claim, the reference must teach every element of a claim. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Vergegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the...claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989). The Examiner bears the burden of presenting at least a *prima facie* case of anticipation. *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138-139 (Fed. Cir. 1986); *In re Wilder*, 429 F.2d 447, 450, 166 USPQ 545, 548 (CCPA 1970). Only if that burden is met, does the burden of going forward shift to the applicant. *In re King*, 801 F.2d at 1327, 231 USPQ at 138-139; *In re Wilder*, 429 F.2d at 450, 166 USPQ at 548. Once a *prima facie* case is established and rebuttal evidence is submitted, the ultimate question becomes whether, based on the totality of the record, the Examiner carried his burden of proof by a preponderance. See *In re Oetiker*, 977 F.2d 1443, 1445. 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If the Examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Since the Examiner failed to show that Shiigi teaches or discloses any one of the above elements, the rejection under 35 U.S.C. §102 is improper.

Therefore, Applicant believes that independent claims 1, 11, and 21, and their respective dependent claims are distinguishable over the cited prior art references. Accordingly, Applicant respectfully requests the rejection under 35 U.S.C. §102(e) be withdrawn.

### ***Rejection Under 35 U.S.C. § 103***

In the Office Action, the Examiner rejected claims 8-9, 18-19, and 28-29 under 35 U.S.C. §103(a) as being unpatentable over Shiigi in view of U.S. Publication No. 2001/0053978 A1 issued to Lewis et al. (“Lewis”). Applicant respectfully traverses the rejection and submits that the Examiner has not met the burden of establishing a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP* §2143, p. 2100-126 to 2100-130 (8th Ed., Rev. 5, August 2006). Applicant respectfully submits that there is no suggestion or motivation to combine their teachings, and thus no *prima facie* case of obviousness has been established.

Furthermore, the Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated: “Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.” MPEP 2141. In *KSR International Co. vs. Teleflex, Inc.*, 127 S.Ct. 1727 (2007) (Kennedy, J.), the Court explained that “[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” The Court further required that an explicit analysis for this reason must be made. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR* 127 S.Ct. at 1741, quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). In the instant case, Applicant respectfully submits that there are significant differences between the cited references and the claimed invention and there is no apparent reason to combine the known elements in the manner as claimed, and thus no *prima facie* case of obviousness has been established.

Shiigi is discussed above.

Lewis discloses a system and method for providing user-directed constraints for handwriting recognition. A user selects between a "default recognition" mode and a "constrained recognition" mode via a user interface. In the default recognition mode, a recognition engine

utilizes predetermined default recognition parameters to decode data (e.g., handwriting and speech). In the constrained recognition mode, the user can select one or more of a plurality of recognition constraints which temporarily modify the default recognition parameters to decode uncharacteristic and/or special data (Lewis, Abstract).

Shiigi and Lewis, taken alone or in any combination, do not disclose or render obvious, at least one of: (1) an encoder to encode data in a first format from an input device into a string of data having a second format supported by a server having an infrastructure, the first and second formats being different; (2) a packetizer coupled to the encoder to break the string of data into packets no larger than maximum message size allowed by the infrastructure, the packets having at least one packet having a header, the header identifying the first format; and (3) a management layer coupled to the packetizer to process the packetized string of data using a processing function, the processing function being enabled or disabled using a configuration user interface

As discussed in the 35 U.S.C. §102(e) rejection above, Shiigi does not disclose or render obvious elements (1) and (2) as above. Accordingly, a combination of Shiigi with any other references in rejecting claims 8, 18, and 28 which include elements (1) and (2), is improper.

The Examiner contends that Shiigi discloses a management layer, citing paragraphs [0012], [0058], and [0060]. However, Shiigi does not contain paragraphs [0058] or paragraph [0060]. **Accordingly, Applicant respectfully requests the Examiner to review the cited prior art reference carefully and identify the correct excerpts.**

Applicant notes that the Examiner includes a discussion on “a decoder” (Office Action, page 5, paragraph 4). Applicant submits that the rejected claims do not contain “a decoder”. Accordingly, Applicant requests the remark on the decoder be removed.

Furthermore, Lewis merely discloses a user to select between a default recognition and a constrained recognition, not a processing function being enabled or disabled using a configuration user interface. A user is not a processing function. Selecting between the two types of recognition is not the same as enabling or disabling the processing function. Selecting allows the user to choose one of the recognition types. It does not allow the user to enable or disable a processing function.

The Examiner failed to establish a prima facie case of obviousness and failed to show there is teaching, suggestion, or motivation to combine the references. When applying 35 U.S.C.

103, the following tenets of patent law must be adhered to: (A) The claimed invention must be considered as a whole; (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) Reasonable expectation of success is the standard with which obviousness is determined.

*Hodosh v. Block Drug Col, Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). "When determining the patentability of a claimed invention which combined two known elements, 'the question is whether there is something in the prior art as a whole suggest the desirability, and thus the obviousness, of making the combination.'" *In re Beattie*, 974 F.2d 1309, 1312 (Fed. Cir. 1992), 24 USPQ2d 1040; *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ (BNA) 481, 488 (Fed. Cir. 1984). To defeat patentability based on obviousness, the suggestion to make the new product having the claimed characteristics must come from the prior art, not from the hindsight knowledge of the invention. *Interconnect Planning Corp. v. Feil*, 744 F.2d 1132, 1143, 227 USPQ (BNA) 543, 551 (Fed. Cir. 1985). To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. In other words, the Examiner must show reasons that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the prior elements from the cited prior references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1996), 47 USPQ 2d (BNA) 1453. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or implicitly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973. (Bd.Pat.App.&Inter. 1985). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Furthermore, although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation

in the reference to do so.” *In re Mills*, 916 F.2d at 682, 16 USPQ2d at 1432; *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992), 23 USPQ2d 1780.

Moreover, the Examiner failed to establish the factual inquires in the three-pronged test as required by the *Graham* factual inquires. There are significant differences between the cited references and the claimed invention as discussed above. Furthermore, the Examiner has not made an explicit analysis on the apparent reason to combine the known elements in the fashion in the claimed invention. Accordingly, there is no apparent reason to combine the teachings of Shiigi and Lewis in any combination.

In the present invention, the cited references do not expressly or implicitly disclose any of the above elements. In addition, the Examiner failed to present a convincing line of reasoning as to why a combination of Shiigi and Lewis is an obvious application of transmitting new data format under existing infrastructure, or an explicit analysis on the apparent reason to combine Shiigi and Lewis in the manner as claimed.

Therefore, Applicant believes that independent claims 1, 8, 11, 18, 21, 28 and their respective dependent claims are distinguishable over the cited prior art references. Accordingly, Applicant respectfully requests the rejection under 35 U.S.C. §103(a) be withdrawn.

***Conclusion***

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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